

REMARKS

Claims 1-8 are all the claims pending in the application. Claims 6-8 were previously withdrawn from consideration.

Claims 4 and 5 have been amended to include the phrase “and an edible carrier.” Support for this amendment can be found, for example, in the specification at page 14, lines 1-20. Claim 5 has been further amended to replace the phrases “the food containing a composition” and “composition” with the phrase “food” for purposes of clarification. Claims 7 and 8 were amended to correct a grammatical error.

Thus, no new matter has been added. Entry of the Amendment is respectfully requested.

I. Response to the Claim Objection Under 37 C.F.R § 1.75

Claim 5 is objected to under 37 C.F.R § 1.75, as being a substantial duplicate of claim 1.

The Examiner asserts that the only difference between claim 1 and claim 5 is in the recitation of “a preparation” versus “a food.” In particular, the Examiner asserts that since claim 5 does not further structurally limit the preamble, the recitation of a food is regarded as future intended use in the same way that the recitation of “a muscle-building preparation” in claim 1 is regarded, and thus is not given patentable weight.

Applicants have distinguished claim 1 from claim 5 by amending claim 5 to recite “an edible carrier.”

In view of the above, withdrawal of the objection to claim 5 is respectfully requested.

II. Response to Rejection of Claims 1-5 Under 35 U.S.C. § 102(b)

At pages 3-5 of the Office Action, claims 1-5 are rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by Takaiohi et al. (WO 91/1512, hereinafter Takaiohi); under 35 U.S.C. § 102(b) as allegedly being anticipated by Shimizu et al. (WO 97/43912, hereinafter

Shimizu); and, under 35 U.S.C. § 102(b) as allegedly being anticipated by Emota et al. (WO 99/34690, hereinafter Emota).

Applicants respectfully traverse. Takaiohi, Shimizu, and Emota do not disclose the present ranges with “sufficient specificity” to constitute an anticipation of the claims.

The Examiner asserts that each of Takaiohi, Shimizu, and Emota teaches the food composition of the present invention. However, the protein, fat, and carbohydrate weight percentage ranges disclosed in the compositions of Takaiohi, Shimizu, and Emota are significantly broader than the claimed ranges of the present invention.

Specifically, Takaiohi discloses an alimentary food comprising 40-65% protein, 5-25% fat, and 15-40% carbohydrates. Shimizu discloses a food composition comprising 10-65% protein, 5-25% fat, and 15-70% carbohydrates on a dry weight basis. Emota discloses a gelled food composition comprising 30-90% saccharides (carbohydrates), 5-40% lipids (fat), and 2-60% protein on a dry weight basis. The present invention discloses a composition comprising 42-55 % protein, 12-20% fat and 23-42% carbohydrates.

Accordingly, the Examiner’s basis for rejecting present claims 1-5 is presumably that the broad genera disclosed in the prior art anticipates the presently claimed species.

Applicants initially point out that “[i]t is well established that the disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus.” *In re Baird*, 16 F.3d 380, 382 [29 USPQ2d 1550] (Fed. Cir. 1994). Indeed, Applicants respectfully submit that the Examiner’s position directly conflicts with the Federal Circuit’s decision in *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006), wherein the court held that a reference temperature range of 100-500 C° did not describe the claimed range of 330-450 C° with sufficient specificity to be anticipatory.

Applicants recognize that “the disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited.” *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1380 [58 USPQ2d 1508] (Fed. Cir. 2001). However, in *Atofina*, the Federal Circuit clarified that a broadly disclosed range was not a “small” genus for purposes of anticipating or disclosing a more limited range. (*See Atofina*, 78 USPQ2d at 1424. “A temperature range of over 100 degrees is not a small genus and the range of temperatures of JP 51-82206 does not disclose *Atofina's* temperature range.”) Here, as in *Atofina*, broadly disclosed protein, fat, and carbohydrate weight percentage ranges are similarly not “small” genera and therefore cannot anticipate the presently claimed ranges.

Moreover, in *Atofina*, the Federal Circuit held that the prior art was not anticipatory based on a single, broadly claimed prior art range. Here, the Examiner rejects the present invention based on three separate weight percentage ranges (protein, fat, and carbohydrate) disclosed in each of Takaiohi, Shimizu, and Emota. Where, in *Atofina*, a single broad range in the prior art could not constitute anticipation, it cannot be said that any of Takaiohi, Shimizu, or Emota, each disclosing three distinct broad ranges describe the present invention with “sufficient specificity” to constitute anticipation.

In view of the above, the Examiner is requested, respectfully, to withdraw the rejections over Takaiohi, Shimizu, and Emota.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No.: 10/534,734

Attorney Docket No.: Q87786

The U.S. Patent and Trademark Office is hereby directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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CUSTOMER NUMBER

Date: November 2, 2009


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